

**REMARKS**

Prior to the present response, claims 1-39 were pending. In the present response claims 1, 3-7, 9, 11, 13-17, 19, 21, 23-25, 29, and 31-36 are amended; and claims 8, 18 and 28 are canceled without prejudice or disclaimer. Accordingly, claims 1-7-9-17, 19-27 and 29-39 currently are pending. In view of the above amendments and the remarks advanced below, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims.

Independent claims 1 and 11 are amended herein to recite, among other things, “requesting ... identity of a plurality of suppliers of at least consumable ... receiving ... information identifying a plurality of suppliers for the at least one consumable in response to the request ... indicating ... one of the identified plurality of suppliers to submit an order for the at least one consumable ....” Similarly, independent claim 21 now recites a combination of features including “a requesting system that requests ... identity of a plurality of suppliers for the at least one consumable ... a receiving system of the peripheral device that receives ... information identifying a plurality of suppliers for the at least one consumable in response to the request; an indication system ... that indicates one of the identified plurality of suppliers ... an ordering system ... for submitting an order for the at least one consumable to the indicated supplier based on the received information, via the communication network.” Support for these features is found, for example, in original claims 1, 8, 11, 18, 21 and 28, and in the specification at page 4, line 28, page 5, line 23, and page 9, line 11 and lines 23-25. Claims 4, 11, and 24 are now written in independent form to include all the features of independent claims 1, 11 and 21, and the intervening dependent claims 3, 13, and 23, respectively.

On pages 3 to 6 of the final office action, the Office maintained the rejection of claims 1-3, 7-9, 11-13, 17-19, 21-23, 27-29 under 35 U.S.C. § 102(e) as allegedly being anticipated by Shibata (US 2002/0008883) (again, the Office fails to mention claims 31-39 in the grounds of rejection, but discusses these claims in the statements of the rejection); on pages 6 to 7, the Office maintained the rejection of claims 4, 14 and 24 under 35 U.S.C. § 103 as allegedly being obvious over Shibata; on pages 7 to 8, the Office maintained the rejection of claims 5, 15 and 25 under 35 U.S.C. § 103 as allegedly being obvious over Shibata in view of Suyehira (US 6,947,161); and on pages 9-10, the Office maintained the rejection of claims 10, 20 and 30 under 35 U.S.C. § 103 as allegedly being obvious over Shibata in view of Borg

et al. (US 6,982,802). The Office also rejects claims 6, 16 and 26 under 35 U.S.C. § 103 as allegedly being obvious over Shibata in view of Suyehira, and further in view of the newly cited Parry et al. patent (US 7,031,013). These rejections are respectfully traversed.

With respect to Applicants' arguments regarding independent claims 1, 11 and 21 as presented in the response dated August 11, 2006, the Office asserts that the data bus 19 and a LAN network 12 of Shibata are communications networks for relaying supplier information, and that contacting a pre-designated supplier for supplying consumables is an act of identification (see, the second paragraph at page 2). In response, Applicants submit that the Office's interpretations of the claimed subject matter and how it may relate to the Shibata publication are unreasonable. First, one of ordinary skill in the art in this field of invention would not interpret the claimed features relating to a request for identifying a supplier of a consumable as reading on the system described in Shibata, which sends an email to a supplier already registered within the apparatus and therefore already known. Second, one of ordinary skill in this field of this invention would not reasonably interpret that the LAN 19 of the Shibata facsimile apparatus as a communications network connected to a peripheral device, as claimed.

Furthermore, independent claims 1 and 11 are now amended to recite, among other things, the features of "requesting, with a peripheral device via a communications network connected to the peripheral device, identity of a plurality of suppliers for at least one consumable for the peripheral device ... indicating, with the peripheral device, one of the identified plurality of suppliers to submit an order for the at least one consumable to the indicated supplier based on the received information, via the communication network." Similar features are now recited by claim 21 in the context of a system. In contrast, the Shibata document describes a system in which only one service depot system (i.e., one supplier) is registered in a "registration unit 3" (see, paragraph 0047, lines 9-13), and an E-mail including information identifying the service depot system is created by the facsimile apparatus and sent to the manager registered in the registration unit 3 over the LAN. More specifically, Shibata discloses:

In the thus-configured Internet facsimile apparatus 1, the facsimile main controller 2 instructs the E-mail data generator 8 to generate E-mail for ordering a consumable product and the E-mail controller 11 to transmit the E-mail to the manager registered in the registration unit 3 when detecting an event such as that the toner needs to be replenished based on detection

information from the consumable product status detector 4. In this case, the E-mail includes the terminal information, order contents, and information of a seller of the toner products such as the service depot system 16. (Paragraph 0057, lines 1-11.) (Emphasis added.)

As the Examiner can appreciate, the above E-mail includes information identifying the one and only supplier. There is simply no description in the Shibata publication that can be considered to reasonably disclose that this E-mail is a request made with a peripheral device via a communication network connected to the peripheral device for identity of a supplier of a consumable for the device, much less a request for identity of a plurality of suppliers and a way or mechanism for indicating of one the plurality of suppliers to submit an order, as presently claimed. Hence, in addition to the claimed distinctions pointed out above and in Applicants' response of August 11, 2006, the Shibata document also fails to describe or suggest the claimed features relating to requesting identity of a plurality of suppliers and indication of one of the identified plurality of suppliers, as now recited in claims 1, 11 and 21.

For at least these reasons, the Shibata publication fails to describe every limitation set forth in independent claims 1, 11 and 21, and therefore Shibata does not anticipate the claimed subject matter.

It is respectfully submitted that the Shibata publication also fails to describe, teach or suggest the combinations features set forth in independent claims 4, 14 and 24. With respect to these claims, the Office acknowledges that Shibata does not disclose the claimed features of "wherein the retrieved information about the peripheral device identifies a location of the peripheral device, and the identifying the at least one supplier is based on the identified location of the peripheral device," and similar subject matter recited in claim 24, but goes on to assert that paragraph 0047 and Figure 3 of Shibata discloses a TTI (transmitter terminal information), that a registration unit 3 registers a TTI of the facsimile device and location information of a manager's PC 13 and the service depot, and that paragraph 0057 describes an Email sent out to for ordering a consumable replacement that includes such information as the terminal information, order contents and the service depot info (see, the last three paragraphs of page 6 to 7, line 2). Next, the Office concludes:

Thus, although Shibata does not explicitly disclose that the service depot is identified based upon a location of the facsimile, it would be obvious to choose a service depot based upon proximity to the service depot. Therefore, it would have been obvious for one of ordinary skill to use an analogous method of identifying a peripheral device (such as using the location of the device).

The motivation of using the TTI is to identify the facsimile so that the correct toner can be ordered. Therefore, it would have been obvious to use Shibata to obtain the invention as specified. (Page 7, line 3 to line 12.)

Before proceeding with an analysis of these statements, the Examiner's attention is directed to MPEP § 2143: **Basic Requirements of a *Prima Facie* Case of Obviousness**. As stated therein, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations" (emphasis added). It is respectfully submitted that the rejection fails to meet these required criteria on several levels.

First of all, and as pointed out above, the "Email sent out to for ordering a consumable replacement" relied upon by the Office includes the address of the supplier (see, Figure 6A, "manager@abc.com," and paragraph 0064, lines 1 to 3). In fact, there is no process described in Shibata that involves a request for an identity of a supplier over the "LAN 12," as alleged by the Office (see, page 4, lines 1 to 5). Rather, the method and apparatus of Shibata obtains the identity of the service depot system from an internal register storing that information (i.e., "registration unit 3," as described in lines 1 to 5 of paragraph 0063 and shown in Figure 3; also see, paragraph 0009, lines 8-12) when the order is made (see, paragraph 0009, lines 16 to 19). That is, the request described in Shibata is not request for an identity of at least one supplier, but instead a request for a consumable from a known and identified supplier sent from the facsimile apparatus 1 over the LAN 12. Hence, Shibata fails to disclose or suggest the claimed features of "requesting, with a peripheral device via a communications network connected to the peripheral device, an identity of at least one supplier for at least one consumable for the peripheral device," as recited in claims 4 and 14, and the feature of "a requesting system that requests, with a peripheral device via a communications network connected to the peripheral device, an identity of at least one supplier for at least one consumable for the peripheral device," as recited in claim 24.

Moreover, each of claims 4 and 14 recites the features of "receiving the request ... identifying the at least one supplier for the at least one consumable based on the received request" and claim 24 recites the features of "an identification system for receiving

the request and identifying the at least one supplier for the at least one consumable based on the request” (Applicants note that the Office fails to address the specific features of claim 24). In connection with this claimed subject matter, the Office simply cites paragraphs 0058 and 0055 of the Shibata publication (see, page 5, lines 16 to 18). However, paragraph 0055 describes an “E-mail analyzer 10,” which is part of the facsimile machine (e.g., see Figure 1), that analyzes E-mail regarding acknowledgements to an order received from the service depot system or request for a service maintenance received from the PC 13 or the service depot system 16. Furthermore, paragraph 0058 of Shibata describes a main controller 2 that instructs the E-mail data generator 8 to generate E-mail for requesting service maintenance and instructs an E-mail controller 11 to transmit the E-mail to the manager and to the service depot system 16, both registered in the registration system 3. It appears the Office is suggesting that the facsimile E-mail analyzer of Shibata receives a request for an identity of a supplier from itself via the LAN, which clearly is not taught, suggested or implied in any way whatsoever in the Shibata publication. If the Office persists in maintaining this rejection, it is requested pursuant to Rule 1.104(c)(2) that the Office provide a clear explanation of the pertinence of the cited parts of Shibata to the claimed feature. Applicants submit there is none.

Furthermore, the Office’s above unsubstantiated statement, “it would have been obvious to choose a service depot based upon proximity to the service depot,” and the motivation provided for modifying Shibata, is merely conclusory because it is not based on evidence from the prior art. The Office also mentions an analogy allegedly existing between identifying a peripheral device and choosing a service depot based on proximity of the peripheral device to the service depot. However, there is no mention, suggestion or hint in the Shibata publication of any relationship of between identifying at least one supplier and the identified location of the peripheral device. As Applicants asserted on page 12 of the response dated August 11, 2006, Shibata does not describe any particulars concerning how a service depot is *chosen*. Absent any teaching or suggestion in Shibata of the claimed features, “receiving the request ... identifying the at least one supplier for the at least one consumable based on the received request” as recited in claims 4 and 14, and the features of “an identification system for receiving the request and identifying the at least one supplier for the at least one consumable based on the request,” as recited in claim 24, it can only be concluded that the Examiner has arrived at his conclusions only after reading Applicants’

own disclosure, and thereafter using only what Applicants have taught against them. Of course, any such basis for showing obviousness is clearly impermissible.

For at least these reasons, the Shibata publication fails to teach or suggest each and every limitation set forth in independent claims 4, 14 and 24. Additionally, the Office's motivation for the proposed modification is unsubstantiated and therefore conclusory. Thus, the rejection fails to establish a *prima facie* case of obviousness within the purview of Section 103. Accordingly, this rejection should be withdrawn.

It is respectfully submitted that the remaining applied documents to Suyehira, Parry et al. and Borg et al. fail to remedy the deficiencies pointed out above with respect to the Shibata publication, whether considered individually or in any combination. Each of these documents are discussed in the following:

As pointed out in Applicants' August 11, 2006, response, the Suyehira patent discloses an automatic ordering system in a printer that includes an orderer (item 124 in Figure 1) configured to receive notice from a detector (item 120) that toner supply is low, and automatically contact a vendor system (item 104) by way of a browser, a modem, or through a host computer (item 102) (see, column 2, lines 19-22 and column 5, lines 8-17). While not explicitly described in the Suyehira patent, it appears that the ordering system in Suyehira is similar to the Shibata system with respect to pre-designating a vendor. That is, Suyehira does not mention anything whatsoever related to identifying any supplier. Hence, Suyehira at least fails to teach or suggest a request for an identity of at least one supplier, as set forth in claims 4, 14 and 24, and consequently, also a request for identity of a plurality of suppliers, as recited in claims 1, 11 and 21, and identifying at least one supplier based on the identified location of the peripheral device, as recited in claims 4, 14, and 24.

The Parry et al. patent is directed to a image forming device that monitors consumables and provides or obtains marketing information such as coupons or price information regarding the consumables. In column 5, lines 23-31, Parry et al. describes an embodiment in which the image forming device generates a request for consumable information that is communicated via an interface to an appropriate network and/or host device connected to the image forming device. The request includes an address such as a

uniform resource locator (URL) of the host (e.g., “hp.com”), which is stored within memory of the image forming device or other location, such as memory in the consumable itself (see, column 5, lines 15-19 and column 6, lines 49-51)). However, like Shibata, a request in Parry et al. appears to have information regarding the identification of a supplier already included in the request. That is, the purpose of the request is to gather price information from a known supplier rather than obtain an identity of a supplier, as recited in each of the independent claims. Furthermore, Parry et al. does not teach or suggest the subject matter of claims 4 and 14 relating to “identifying the at least one supplier is based on the identified location of the peripheral device,” and similar subject matter recited in claim 24

The Borg et al. patent discloses a system and method that includes loading a application on the user’s computer, which is supplied by the manufacturer to entice the user to buy consumables from the manufacturer. In such a system, the identity of the supplier (i.e., the manufacturer) is not only known, but appears exclusive of any other suppliers (see, column 1, line 59 to column 2, line 2 and lines 25-28, and column 6, lines 17-19). Hence, there is no need in the Borg et al. system to requesting an identity of a supplier. Accordingly, Borg et al. does not remedy the shortcomings of Shibata with respect to independent claims 1, 4, 11, 14, 21 and 24.

The remaining rejected claims depend from one of claims 1, 11 and 21, and therefore are allowable for at least the reasons pointed out above. Additionally, these dependent claims recite combinations of features defining further points of distinction not taught by the Shibata, Suyehira, Parry et al. and Borg et al. documents, whether taken alone or in combination. However, because the distinctions set forth in the independent claims is clear, Applicants will not belabor a detailed discussion of the separately patentable features recited in each and every dependent claim at this time. However, Applicants reserve the right to argue these distinctions at a later time, if necessary.

In view of all of the foregoing, Applicants respectfully request that the Office reconsider and withdraw the rejections of the claims, and allow the present application without further delay. Such allowance is earnestly solicited.

Respectfully submitted,

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